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1 MR. MARSH: Good morning.

2 JUDGE GREEN: If you could introduce your associate.

3 MR. MARSH: Sure. David Marsh with Arnold & Porter. My  
4 colleague Lisa Adelson also at Arnold & Porter. Thank you.

5 JUDGE GREEN: And if you have a card for the court reporter --

6 MR. MARSH: Probably.

7 JUDGE GREEN: -- that would be great.

8 MR. MARSH: Can I give it to him at the end?

9 JUDGE GREEN: Yes, that's fine.

10 MR. MARSH: Thanks.

11 JUDGE GREEN: Okay, we have reviewed your case and are familiar  
12 with it and familiar with the issues, and you have 20 minutes from whenever  
13 you're ready to begin.

14 MR. MARSH: Thank you. I just -- I think the case is at least  
15 relatively straightforward on its face. It doesn't raise too many issues. I  
16 think the -- there's both a written description, as you know, and -- I'd like to  
17 start with, if it pleases the court, with the written description rejection.

18 The Examiner is reading the specification to require additional  
19 elements in the claim beyond the claim itself and says that it's either new  
20 matter to have a claim without those elements or lacking some other aspect  
21 of written description. I'm sorry to be vague on that point. It's not entirely  
22 clear to the Applicant is that meets and bounds of the Examiner's rejection  
23 on that point. I think what is clear is that the application clearly envisions  
24 both a nucleic acid molecule -- and comprising other things. In all of the  
25 incidences pointed to by the Examiner for requirements for others like

1 promoters, terminators and the like, they're all within the contents of the  
2 may be additional parts of the plug. None of them say must or essential or  
3 got to have or any of those sorts of words. All of them say you may have a  
4 promoter. You may have a terminator, and through the dialogue between  
5 the Examiner that he reviewed in the record, the Examiner has failed I think  
6 completely to point to anything that says here's the requirements, and we  
7 know of nothing under the law that says that we should have any additional  
8 elements nor anything in the specification that tells you you should have  
9 those. So Applicants are somewhat surprised at this rejection.

10 And just for instance, it's very clear, I'll pick one of the examples in  
11 the specification, one or more nucleic acid molecules in the present this  
12 invention may be used in plant transformation or -- it's very open. It's not  
13 closed. It says one or more, and this is clearly one or more of the nucleic  
14 acid molecules of the present invention. Indeed, it's recited in allowed  
15 claim, claim 12. So it couldn't be clearly more which is than an allowed  
16 claim. So I think it's -- there is clearly no new matter by this claim  
17 whatsoever in light of the clear recitation in the specification.

18 There's also recitation, similar recitations with respect to other host  
19 cells but mainly in fungal like that. That same sentence appears in the  
20 additional places in the specification. So on the written description, it is  
21 clearly supported. There is no reason to have additional limitations to the  
22 claim. The claim is an open claim. It -- and clearly you could have a  
23 promoter. You clearly could have a terminator. You could have all sorts of  
24 other things, because that's the word comprising for you. So on its face, the  
25 claim is open to the other elements that the Examiner would like to put in

1 but does not require them, and nowhere in the specifications does it say they  
2 must be there or must be present. So -- and it's a very standard sort of  
3 format, so I think it's sort of an unusual conjecture in that way.

4 The second part of the Examiner's rejections with respect to  
5 enablement has somewhat of the same nugget or essence as the first part.  
6 The Examiner is wanting to have expression of the protein. Nowhere in the  
7 claim does it say that the protein has to be expressed, nor does it say there's  
8 a protein. It just says that that comprises a nucleic acid molecule -- the  
9 Examiner flags that there is potential frame shifts in the nucleic acid  
10 molecule, but again no expression is required here, and even if there was  
11 expression, there are lots of uses for express nucleic acid molecules in plants  
12 that don't require the protein, antisense or co-suppression or both, disclosed  
13 in the specification --

14 The claims as an outset do not require expression. So sort of the  
15 Examiner is again trying to read in limitations into the claim that are just not  
16 there and just not necessary. Even if expression was necessary, expression  
17 of a protein with a transcript with a frame shift and for translation still would  
18 not eliminate uses of that particular transcript, because co-suppression and  
19 antisense could work with that degree of mismatch if necessary.

20 But that's not what the Examiner is saying. The Examiner is saying  
21 what you need is you need to express the protein. You haven't enabled it  
22 because there's not a promoter. There's a frame shift, but that's not what the  
23 claim requires. When you look at both written description and enablement,  
24 you look at the enablement of the claim as opposed to some claim that I  
25 think is in the Examiner's head as to the -- what she wants to have, you

1 know, traditional expression of a protein type of claim, but that's not what  
2 this is. This is a claim which says a transformed plant, I'm just taking claim  
3 20 as an example, comprising of a common nucleic acid molecule, I'm in the  
4 nucleic acid sequence of claim 12 claims what the nucleic acid sequence is  
5 disclosed -- is going to be our -- nucleic acid sequence is implied. That's the  
6 question for enablement. The question for enablement is not will it express  
7 a protein, because there's no requirement that's reading in a complete  
8 limitation. It's just not there. So I think in both these situations where the  
9 Applicant and the Examiner are passing like ships in the night is the --  
10 because in the Applicant's view, you've got to focus on the words in the  
11 claim, and that's what we're claiming. We're not claiming something else.  
12 We're claiming just those words. They may encompass other things, but  
13 that's a different question. So that's really the essence. I think it's a very  
14 straightforward question there, at least in the minds of the Applicants for the  
15 -- that's in essence where the Applicant is and where the Examiner is.

16 JUDGE WALSH: Assuming the Examiner thinks that the only use  
17 that the transformed plant has is to make protein, what are the other uses?

18 MR. MARSH: Let me answer that the Examiner hasn't said that. It's  
19 not a utility rejection per se.

20 JUDGE WALSH: Well, they're taking it as having taught how to use.

21 MR. MARSH: Yeah, having taught --

22 JUDGE WALSH: If they -- if the Examiner thought, for whatever  
23 reason, that the only use being taught was to make a protein, what other uses  
24 were being taught?

25

1           MR. MARSH: Assuming that that was the Examiner's thinking, there  
2 are other uses within the specification that are clearly set forth. Both  
3 antisense and co-suppression are set forth in the specification itself and  
4 would be aware of somebody of ordinary skill in the art at the time that this  
5 was filed would know of both of those technologies. They weren't as  
6 refined as they are now, but both existed, both antisense and co-suppression.  
7 So in neither of those cases would you need to express a protein, and your  
8 point is a good point vis a vis the use, but there are other uses in the  
9 specification with respect to if you had a frame shift that the Examiner has  
10 put forward in the transcript, it would still be sufficient to have co-  
11 suppression and/or antisense, because you can have some mismatch in both  
12 of those areas for suppression. So I think that that's the -- I do think the  
13 Examiner was very much focusing on the expression part and  
14 notwithstanding that.

15           JUDGE GREEN: Any further questions? No? I think we  
16 understand.

17           MR. MARSH: Very much appreciate your time and --

18           JUDGE GREEN: And if you have your card for the court reporter,  
19 and if he has any questions for you.

20           MR. MARSH: Sounds good. Thank you very much.

21           JUDGE GREEN: Thank you.

22           (Whereupon, the hearing concluded on August 4, 2009.)  
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